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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hiroshi Matoba

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EXAMINER

JONES, HEATHER RAE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/047,047

Applicant(s)

MATOBA ET AL.

Examiner

HEATHER R. JONES

Art Unit

2621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11, 13-23, 25-38, 40-42, 46, 47 and 49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,3-11, 13-23, 25-27, 38, 40-42 and 49 is/are allowed.
- 6) ☒ Claim(s) 28-37, 46 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed April 23, 2009 have been fully considered but they are not persuasive.

The Applicant argues that Wood et al. fails to suggest a controller that transfers the program data selected by the user as a program data to be permanently stored in the permanent memory. The Examiner respectfully disagrees. Wood et al. discloses in paragraph [0129] a scenario where the user decides to press record during a live broadcast and when this happens the program that has been selected has been being recorded in the rewind buffer (temporary storage) and stores the program information in the rewind buffer along with the rest of the program in permanent storage. Therefore, Wood et al. meets the claimed limitations and the rejection is maintained.

The Applicant argues that Wood et al. fails to disclose displaying a period of time for which the program data stored in the temporary memory is held. The Examiner respectfully disagrees. Wood et al. discloses in paragraph [0059] discloses that the rewind buffer can be made up of a "circular file" of a non-circular file which can be varied accordingly. Furthermore, Wood et al. explains in paragraph [0117] that the user can set the length of the rewind buffer. Therefore, in order for the user to be able to set the length of the rewind buffer the user would need to be able to see the length of the display buffer. Therefore, Wood et al. meets the claimed limitations and the rejection is maintained.

The Applicant argues that Wood et al. fails to disclose continuously recording a predetermined channel. The Examiner respectfully disagrees. Wood et al. discloses in paragraph [0129] where the channel is continuously recorded in the rewind buffer in order to allow the user to be able to rewind the program at any minute as well as to decide to record the program at the last minute or even during the middle of it. The predetermined channel is the channel the tuner is currently on. Therefore, Wood et al. meets the claimed limitation of continuously recorded a predetermined channel.

The Applicant argues that Wood et al. fails to disclose the system playing back the program on the other channel at the same time as the program which is presently played back. The Applicant goes on to state that this allows the user to freely change channels as if viewing programs on a real-time basis (but where the programs were recorded in the past). The Examiner respectfully disagrees. Wood et al. discloses in paragraphs [0082]-[0111] a list being displayed to show the recordings saved on the device or devices if they are connected on a master/slave connection. It is well known that once a user selects a program to watch then that respective device that is storing the program will play back the program. Furthermore, by displaying a list of programs the user can switch amongst the programs as freely as they would like thereby simulating watching programs on a real-time basis. Therefore, Wood et al. meets the claimed limitations and the rejection is maintained.

The Applicant argues that Wood et al. fails to disclose predicting which apparatus will playback will occur based upon which program is highly likely to be played back. The Examiner respectfully disagrees. Wood et al. discloses in paragraphs [0082]-[0111] a list being displayed to show the recordings saved on the device or devices if they are connected on a master/slave connection. It is well known that once a user selects a program to watch then that respective device that is storing the program will play back the program. Furthermore, it is also well known that the apparatus contains navigation information so that when a program is selected from the list of recordings then that program can be played without a delay. Therefore, Wood et al. meets the claimed limitations and the rejection is maintained.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 28, 29, 31-37, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Wood et al. (U.S. Patent Application Publication 2002/0057893).

Regarding claim **28**, Wood et al. discloses an apparatus for recording and storing a broadcast program, said apparatus comprising: a temporary memory for temporarily storing up to a predetermined amount of program data; a permanent memory for storing program data selected by the user as program data to be permanently stored from among the program data stored in said temporary memory; a recording controller for successively storing the program data of programs set for timer recording in said temporary memory, and partly deleting the program data recorded in said temporary memory in the past if the program data stored in said temporary memory exceeds said predetermined amount (paragraph [0059]); a saving controller for transferring the program data selected by the user as program data to be permanently stored from among the program data stored in said temporary memory to said permanent memory; and a playback controller for playing back a program selected by the user from the programs whose program data have been stored in said temporary memory and/or said permanent memory (Figs. 2 – each device is the same so they both include all the components of Fig. 2; paragraphs [0030] and [0067] – Master and slave both include tuners; paragraph [0030] - the user sees the two devices as one device; paragraphs [00082] and [0111] - a list is displayed to show the recordings saved on the device; paragraph [0129] - record a program that has been in the buffer).

Regarding claim **29**, Wood et al. discloses an apparatus according to claim 28, wherein said recording controller has means for displaying a period of

time for which the program data stored in said temporary memory are held, on an output device for displaying programs (paragraphs [0059] and [0129]).

Regarding claim **31**, Wood et al. discloses a system for recording a program broadcast on at least one channel, storing program data of the program, and playing back the program when instructed by the user, said system comprising: one or more slave apparatus for automatically continuously recording a program on a predetermined channel and playing back the recorded program as instructed; and a master apparatus for, when the user is to determine a channel on which each of the slave apparatus automatically continuously records a program and to select a program to be played back on the channel, displaying a list of programs recorded by all the slave apparatus in association with channels and times at which the programs are recorded, on an output device for displaying programs, and, if a program to be displayed is selected by the user with a channel and a time, controlling the slave apparatus which has recorded the program to play back the program, and, if the user changes the channel to another channel, controls the slave apparatus which has recorded a program on the other channel at the same time as the former channel to play back the program on the other channel (Figs. 2 – each device is the same so they both include all the components of Fig. 2; paragraphs [0030] and [0067] – Master and slave both include tuners).

Regarding claim **32**, Wood et al. discloses all the limitations as previously discussed with respect to claim 31 including that the slave apparatus comprise

respective add-on modules that can be incorporated in said master apparatus (paragraph [0030] - the user sees the two devices as one device, therefore, the modules of the slave are incorporated in the master).

Regarding claim **33**, Wood et al. discloses all the limitations as previously discussed with respect to claim 31 including that the slave apparatus comprise a desired number of software modules that can be executed by said master apparatus (Fig. 2; paragraph [0030] - the user sees the two devices as one device).

Regarding claim **34**, Wood et al. discloses a system for recording and storing a program broadcast on at least one channel, said system comprising: a master apparatus; and one or more slave apparatus; said master apparatus comprising: a first memory for storing the program data of recorded programs; a first decoder for decoding program data read from said first memory; and a controller for grasping programs recorded by each of all the apparatus, and, if the program data of a program instructed by the user to be played back is store in the first memory of the master apparatus, reading the program data from said first memory, decoding the program data into a program signal with said first decoder, outputting the program signal to an output device for displaying programs, and, if the program data of a program instructed by the user to be played back is stored in a slave apparatus, instructing the slave apparatus to play back the program, outputting a program signal received from the slave apparatus to said output device, and, if the program data of a program which is highly likely

to be played back by a subsequent control action of the user is stored in the first memory of the master apparatus, preparing the master apparatus to read the program data from said first memory and decode the program data with said first decoder, and, if the program data of a program which is highly likely to be played back by a subsequent control action of the user is stored in a slave apparatus, instructing the slave apparatus to prepare said slave apparatus to play back the program; and each of said slave apparatus comprising: a second memory for storing said program data; a second decoder for decoding the program data read from said second memory into a program signal; and a controller for reading the program data of a program instructed by said master apparatus to be played back from said second memory, decoding the program data into a program signal with said second decoder, transmitting the program signal to said master apparatus, reading the program data of the program instructed to be prepared for playback from said second memory, and preparing said second decoder to decode the program data (Figs. 2 – each device is the same so they both include all the components of Fig. 2; paragraphs [0030] and [0067] – Master and slave both include tuners; paragraph [0030] - the user sees the two devices as one device; paragraphs [0083] and [0111] - a list is displayed to show the recordings saved on the device).

Regarding claim 35, Wood et al. discloses all the limitations as previously discussed with respect to claim 34 including that the slave apparatus comprise respective add-on modules that can be incorporated in said master apparatus

(paragraph [0030] - the user sees the two devices as one device, therefore, the modules of the slave are incorporated in the master).

Regarding claim **36**, Wood et al. discloses all the limitations as previously discussed with respect to claim 34 including that the slave apparatus comprise a desired number of software modules that can be executed by said master apparatus (Fig. 2; paragraph [0030] - the user sees the two devices as one device).

Regarding claim **37**, Wood et al. discloses an apparatus in a system for recording and storing a program broadcast on at least one channel, said apparatus comprising: a memory for storing the program data of recorded programs; a decoder for decoding program data read from said memory; and a controller for grasping programs recorded by each of all apparatus of the system, and, if the program data of a program instructed by the user to be played back is stored in the memory of the apparatus itself, reading the program data from said memory, decoding the program data into a program signal with said decoder, outputting the program signal to an output device for displaying programs, and, if the program data of a program instructed by the user to be played back is stored in an apparatus other than said apparatus itself, instructing the other apparatus to play back the program, outputting a program signal received from the other apparatus to said output device, and, if the program data of a program which is highly likely to be played back by a subsequent control action of the user is stored in the memory of said apparatus itself, preparing the apparatus itself to

read the program data from said memory and decode the program data with said decoder, and, if the program data of a program which is highly likely to be played back by a subsequent control action of the user is stored in an apparatus other than the apparatus itself, instructing the other apparatus to prepare said other apparatus to play back the program (Figs. 2 – each device is the same so they both include all the components of Fig. 2; paragraphs [0030] and [0067] – Master and slave both include tuners; paragraph [0030] - the user sees the two devices as one device; paragraphs [00082] and [0111] - a list is displayed to show the recordings saved on the device).

Regarding claims **46** and **47**, these are computer program claims corresponding to the system and apparatus claims 28, 31, 34, and 37. Therefore, claims 46 and 47 are analyzed and rejected as previously discussed with respect to claims 28, 31, 34, and 37.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wood et al. as applied to claim 28 above, and further in view of Tanaka (U.S. Patent 7,072,576).

Regarding claim **30**, Wood et al. discloses all the limitations as previously discussed with respect to claim 28, but fails to disclose that the apparatus further comprises means for allowing the user to set memory capacities to said temporary memory and said permanent memory.

Referring to the Tanaka reference, Tanaka discloses apparatus comprising means for allowing the user to set memory capacities to said temporary memory and said permanent memory (Fig. 2; col. 6, lines 58-67 – if the temporary memory capacity is changed then the permanent memory is changed as can be seen from Fig. 2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have allowed the user to change the capacities of the temporary and permanent as taught by Tanaka in the apparatus disclosed by Wood et al. in order to allow the user to change the memories to accommodate one's own viewing styles, if the user records more then they would want less of a temporary memory and more of a permanent memory.

Allowable Subject Matter

6. Claims 1, 3-11, 13-23, 25-27, 38, 40-42, and 49 are allowed for reason set forth in the previous Office Action dated December 23, 2008.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Heather R Jones
Examiner
Art Unit 2621

HRJ
July 16, 2009

/HUY T NGUYEN/
Primary Examiner, Art Unit 2621